

### REMARKS

A restriction requirement must indicate why the inclusion of multiple inventions represent a burden to the office (see MPEP 803 - "If the search and examination of an entire application can be made without serious burden, *the examiner must examine it on the merits*, even though it includes claims to independent or distinct inventions."). For this application, the presumption of a serious burden on the office is made on the basis of differing classification and different classes of invention. However, this is a rebuttable presumption (see MPEP 803, section II) and the applicants request reconsideration of the restriction requirement for the reasons below. In addition, as this application is a National Stage application of a PCT application, the standard for determining whether the application should be restricted is whether the application possesses a special technical feature.

Given that the process claims (claims 1-6 – Group I) by definition would make the hydroxyalkylalkylcellulose of the claims of Group II, the results of the search used for the claims of Group I would also be used in the search for the hydroxyalkylalkylcellulose of Group II. Therefore, it is unclear why claims 7-12 represent an undue burden on the office.

Even if additional support for an undue burden was given by the Examiner and this restriction is maintained, the applicants note that claims 7-12 are directly or indirectly linked to claim 1. MPEP 809.03 "Linking Claims" states:

"The most common types of linking claims which, if allowed, act to prevent restriction between inventions that can otherwise be shown to be divisible, are

- (A) genus claims linking species claims;
- (B) **a claim to the necessary process of making a product linking proper process and product claims;**
- (C) a claim to "means" for practicing a process linking proper apparatus and process claims; and
- (D) a claim to the product linking a process of making and a use (process of using)."

Type (B) most closely resembles the claims of the invention. As such, the Examiner is reminded that MPEP 809 states in part that "[t]he **linking claims must be examined with the invention elected**, and should any linking claim be allowed, the restriction requirement must be withdrawn." (emphasis added)

Lastly, the restriction requirement erred in asserting that the applicants' invention lacks a special technical feature which relates the invention together. However, the special technical feature is the process of making the hydroxyalkylalkylcellulose which was recognized by the reviewer in the PCT application, i.e. U.S. 4,477,657 (Strange et al.) which was used as allegedly showing a lack of a special technical feature was cited only as an "A" reference in the International Search Report for the PCT application (WO 2007-078015) upon which this application is a National Stage application.

Attention is also directed to "According to the Report of the PCT Assembly, 18<sup>th</sup> Session (1991), item 25 (WIPO Document PCT/A/XVIII/9), the PCT Contracting States have agreed that the Patent Cooperation Treaty provisions as to unity of invention **would continue to apply in the national phase**. This means that **designated Offices should not raise an objection to lack of unity if no such opinion is expressed in the international search report.**" (from PCT Handbook Release 6 (2000)). As no lack of unity of invention or election of species was made in the international search report, a lack of unity of invention should not be made for the U.S. national stage application.

For any of the above reasons, i.e. (1) no undue burden on the Office; (2) use of linking claims; and (3) no previous holding of lack of unity, the restriction requirement should be withdrawn. (Applicants acknowledge the possibility of rejoinder under MPEP 821.04 as noted in the restriction requirement.)

**CONCLUSION**

In view of the above, reconsideration and withdrawal of the restriction requirement is respectfully requested. It is also believed that the application is in condition for allowance, and favorable consideration of the application and prompt issuance of a Notice of Allowance are earnestly solicited. Favorable action is earnestly solicited.

Respectfully submitted,  
FROMMER LAWRENCE & HAUG LLP

By: /Howard C. Lee/  
Ronald R. Santucci     Howard C. Lee  
Reg. No. 28,988         Reg. No. 48,104  
Telephone:     (212) 588-0800  
Facsimile:     (212) 588-0500